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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,542	08/03/2001	Daniel L. Schwarz	P-5204	6838

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EXAMINER
SORKIN, DAVID L

ART UNIT	PAPER NUMBER
1723	6

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/921,542	SCHWARZ ET AL.	
	Examiner	Art Unit	
	David L. Sorkin	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *11-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-18* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 6 is acknowledged.

2. Applicant states "[t]he apparatus and method both employ a sample vessel holder". However, this statement is simply not true. The method, as claimed, requires no vessel holder.

3. Applicant states "[t]he apparatus and method both employ a magnet driver". However, this statement is simply not true. The method, as claimed, requires no magnet driver.

4. More generally, applicant states that "all the claims of the present invention share common subject matter". To the contrary, a partial catalog of the differences is presented below:

a. The method claims require a stirrer, while the apparatus claims do not.

b. The method claims require a vessel, while the apparatus claims do not.

c. The method claims require a magnet, while the apparatus claims do not.

d. The apparatus claims require a holder, while the method claims do not.

e. The apparatus claims require a driver, while the method claims do not.

f. The method claims require a particular orientation of the vessel with respect to horizontal, while the apparatus claims are not limited by such an intended use.

g. The method claims are limited to stirring a solid suspended in a liquid, while the apparatus claims are not limited by such an intended use.

5. The apparatus claims require a combination of exactly two structural elements, a holder and a driver. Neither of these structural elements is required by the method.

6. As explained in the restriction requirement (paper No. 6) the claimed process could be practiced with a materially different apparatus and the claimed apparatus could be used to practice a materially different process. For example, while the method is limited to "stirring a solid suspended in a liquid", the apparatus could be used to stir other types of material such as a liquid alone. While the apparatus claim includes the words "stirring a solid suspended in a liquid", as held in *Ex parte Thibault,* 164 USPQ 666,667 (Bd. App. 1969), "Expressions relating the apparatus to contends thereof during an intended operation are of no significance in determining patentability of the apparatus claim". The apparatus could be used without the stirrer, as is common in molten metal stirring, by direct action of the magnetic field on the molten metal. Also, the method could be practiced by holding the vessel by hand, instead of by using the "vessel holder" required by the apparatus claims. Also, the method could be practiced by moving the magnet by hand, instead of by using the "magnet driver" required by the apparatus claims.

7. The decision cited by applicant, *In re Kuehl* 177 USPQ 250 (CCPA 1973), regards rejection of claims and does not even remotely address restriction requirements.

8. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Karkos, Jr. et al. (US 6,095,677). Regarding claim 1, Karkos ('677) discloses a system comprising a holder (50) and a driver (26). While the system is capable of performing the intended operations discussed in the claim, applicant is advised that "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Also, "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Furthermore, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967) and "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto,* 136 USPQ 458,459 (CCPA 1963). Regarding claim 2, a magnet shaft assembly (including shaft 70) having a magnet coupled thereto and a motor (28) are disclosed. Regarding claim 3 the magnet shaft assembly is rotatable (see col. 5, lines 60-65). See the decisions cited above regarding the intended use(s) discussed in the claim. Regarding claim 4, said motor is

magnetically couple to the shaft assembly (see col. 5 line 42 to col. 6 line 4). Claims 5 and 8 merely discuss a stirrer that is not part of the claimed apparatus and therefore fail to structurally further limit the claimed apparatus. Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do, however, "apparatus claims cover what a device *is*, not what a device *does*" *Hewlett-Packard Co. v. Bausch & Lomb Inc, supra.*

11. Claims 1 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ullman (US 5,120,135). Regarding claim 1, Ullman ('135), discloses a system comprising a holder (28) and a driver (29) (see Fig. 8; col. 7, lines 32-47). While the system is capable of performing the intended operations discussed in the claim, applicant is advised that "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* supra. Also, "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham,* supra. Furthermore, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* supra. and "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto,* supra. Nonetheless, Ullman ('135) also discusses the intended use of stirring a solid suspended in a liquid (see abstract) in a sample vessel (12). Also, the intended inclusion of a stirrer (18) in the intended vessel is disclosed. The intention of the intended vessel be of such a shape that it possesses a longitudinal axis is also depicted in, for example Figs. 1-3. Furthermore, the intended use of the magnet driver moving a magnet (20,32) intended

to be used with the claimed system proximate an outer surface of said sample vessel to permit said magnet to impose a magnetic influence on said stirrer to move said stirrer on said sample vessel is disclosed (see Fig. 8, col. 7, lines 32-47). Claims 5 and 8 merely discuss a stirrer that is not part of the claimed apparatus and therefore fail to structurally further limit the claimed apparatus. Nonetheless, a stirrer (18) which is intend to be used with the claimed system including a ferrous metal according to claim 5 is discussed (see col. 6, lines 31-56) and such a stirrer including a rare earth magnet according to claim 8 is also disclosed (see col. 6, lines 31-56). Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do, however, "apparatus claims cover what a device *is*, not what a device *does*" *Hewlett-Packard Co. v. Bausch & Lomb Inc, supra*. Nonetheless, regarding claim 6, Ullman ('135) also discusses the intended use of moving a magnet (20,32) intended to be used with the claimed system such that it moves a stirrer (18) intended to be used with the claimed system along a side wall of a sample vessel (12) intended to be used with the claimed system (see, for example, abstract and Figs. 1-3). Likewise, regarding claim 7, Ullman ('135) also discusses the intended use of moving a magnet (20,32) intended to be used with the claimed system away from an outer surface of a sample vessel (12) intend to be used with the claimed system to allow gravity to move a stirrer (18) intended to be used with the claimed system toward a bottom of said sample vessel (see Figs. 1-3 and col. 6 line 65 to col. 7 line 18).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David Sorkin

February 20, 2003

CHARLES E. COOLEY
PRIMARY EXAMINER